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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,804	02/09/2001	David L. Goodale	2048-039	8653
22471	7590	12/23/2003	EXAMINER	
PATENT LEGAL DEPARTMENT/A-42-C BECKMAN COULTER, INC. 4300 N. HARBOR BOULEVARD BOX 3100 FULLERTON, CA 92834-3100			QUAN, ELIZABETH S	
		ART UNIT		PAPER NUMBER
		1743		
DATE MAILED: 12/23/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/780,804	GOODALE ET AL.
	Examiner	Art Unit
	Elizabeth Quan	1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 03 October 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-31 is/are pending in the application.  
 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 and 21-31 is/are rejected.  
 7) Claim(s) 7 and 27 is/are objected to.  
 8) Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of invention I, claims 1-10 and 21-30 in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Objections***

2. Claims 7 and 27 are objected to because of the following informalities: In line 4, "matingly locked" should be replaced with "to matingly lock". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4-6, 21-27, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,598,393 to Mater.

Mater discloses an apparatus for piercing poles comprising a piercing blade (120) having a longitudinal axis and a zigzagged cross-section that is perpendicular to said axis and means for moving the blade for piercing comprising a carriage assembly (22,50) for moving the blade and means for driving the carriage assembly (90) (figs. 1-10; col. 2, line 11-col. 5, line 36). The piercing blade has at least one sharpened tip (129,132,136,138) for piercing and spreading the

load applied on the blade (fig. 7; col. 2, line 68-col. 3, line 44). An alignment block assembly restrains the pole when the piercing blade is being withdrawn after piercing the pole (figs. 9 and 10; col. 3, line 67-col. 4, line 23). The alignment block assembly comprises a latch assembly for latching the alignment block assembly when the piercing blade is being withdrawn from the pole to prevent the container from being moved by friction with the withdrawn blade (figs. 9 and 10; col. 3, line 67-col. 4, line 23). The latch assembly comprises a trigger movable between a latching position to securely hold the pole in position when the piercing blade is being withdrawn from the pole and unlatched position to lower the pole onto the chains after the piercing blade has been withdrawn from the pole (figs. 9 and 10; col. 3, line 67-col. 4, line 23). The latch assembly comprises an actuator engaged with the trigger wherein the actuator has locking means (figs. 9 and 10; col. 3, line 67-col. 4, line 23). When the trigger moves to the latching position, the actuator causes its locking means to matingly lock with a fixed complimentary locking means to latch the alignment assembly (figs. 9 and 10; col. 3, line 67-col. 4, line 23). When the trigger moves to the unlatched position, the actuator causes its locking means to unlock from the fixed complimentary locking means to unlatch the alignment assembly (figs. 9 and 10; col. 3, line 67-col. 4, line 23).

Since the claims have not positively recited the cap, the cap has not been accorded patentable weight.

5. Claims 1-10 and 21-31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,182,208 to Bruno et al.

Bruno et al. disclose an apparatus for piercing plastic comprising a piercing blade (31) having a longitudinal axis and a zigzagged cross-section that is perpendicular to said axis and

means for moving the blade for piercing comprising a carriage assembly (70) for moving the blade and means for driving the carriage assembly (figs. 1-5). The piercing blade has at least one sharpened tip for piercing and spreading the load applied on the blade (figs. 1-5; col. 3, lines 59-63). An alignment block assembly restrains the plastic when the piercing blade is being withdrawn after piercing the plastic (col. 3, line 48-col. 6, line 13). The alignment block assembly comprises a latch assembly for latching the alignment block assembly when the piercing blade is being withdrawn from the plastic to prevent the container from being moved by friction with the withdrawn blade (col. 3, line 48-col. 6, line 13). The latch assembly comprises a trigger movable between a latching position to securely hold the pole in position when the piercing blade is being withdrawn from the plastic and unlatched position to lower the pole onto the chains after the piercing blade has been withdrawn from the plastic (col. 3, line 48-col. 6, line 13). The latch assembly comprises an actuator engaged with the trigger wherein the actuator has locking means (col. 3, line 48-col. 6, line 13). When the trigger moves to the latching position, the actuator causes its locking means to matingly lock with a fixed complimentary locking means to latch the alignment assembly (col. 3, line 48-col. 6, line 13). When the trigger moves to the unlatched position, the actuator causes its locking means to unlock from the fixed complimentary locking means to unlatch the alignment assembly (col. 3, line 48-col. 6, line 13). The locking means of the actuator and fixed complimentary locking means are gear rack teeth or saw teeth (figs. 1 and 5). The actuator is spring-biased (col. 3, line 48-col. 6, line 13).

Since the claims have not positively recited the cap, the cap has not been accorded patentable weight.

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6. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,271,882 to Valo or U.S. Patent No. 5,674,237 to Ott or U.S. Patent No. 4,611,579 to Bellhouse or U.S. Patent No. 4,558,868 to Musacchia.

Each of the cited references disclose a piercing blade having a longitudinal axis and a zigzagged cross-section that is perpendicular to the axis where in the piercing blade has at least one sharpened tip for piercing and spreading the load applied on the blade. Valo discloses a blade for a cutter for a chipper or similar wood reducing machine (fig. 3; col. 2, lines 32-59). Ott discloses in laparoscopic trocar technique also known as z-puncture is performed by pushing the z-shaped path of the trocar through tissue to gain access to internal body cavities or place an access cannula for endoscopic surgery (col. 2, lines 30-44). Bellhouse discloses laryngoscope blades with a z-shaped cross section (abstract; fig. 5; col. 3, lines 7-20). Musacchia discloses arrowheads with zigzagged cross section for target practice or hunting (fig. 30; col. 13, lines 32-54).

Since the claims have not positively recited the cap, the cap has not been accorded patentable weight.

#### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 8, 9, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,598,393 to Mater in view of U.S. Patent No. 3,310,990 to Zettel or U.S. Patent No. 3,273,248 to Halverstadt or U.S. Patent No. 1,485,460 to Johnston.

Mater fails to disclose that the actuator and fixed complimentary locking means are gear rack teeth or saw teeth. It is noted that the Applicant has not distinguished between gear rack teeth and saw teeth. It appears that the Applicant is differentiating the teeth by different methods of making teeth. Method limitations are accorded no patentable weight in apparatus claims if the prior art teaches or suggests the structural limitations. Gear rack teeth and saw teeth have been treated as the same structural element with different names. However, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Mater to use gear rack teeth or saw teeth since it is a very well known mechanical locking structure to securely hold two structures in the desired position as taught or suggested by Zettel or Halverstadt or Johnson.

11. Claims 10 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,598,393 to Mater.

Mater fails to disclose that the actuator is spring-biased. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a spring-biased actuator since it is a very well known mechanical structure for absorbing shock, restricting moving beyond desired positions, and biasing structures toward a certain position.

*Response to Arguments*

12. Applicant's arguments with respect to claims 1-10 and 21-31 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Quan  
Examiner  
Art Unit 1743

eq

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700